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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,668

12/08/2003

Lori N. Cross

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SHOOK, HARDY & BACON L.L.P.
Intellectual Property Department
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EXAMINER

LUBIN, VALERIE

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

08/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,668

Applicant(s)

CROSS ET AL.

Examiner

VALERIE LUBIN

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Individual Patent Application
- 6) ☒ Other: EAST search history
- Paper No(s)/Mail Date _____

DETAILED ACTION

Acknowledgements

1. Claims 1-21 are pending

For reference purposes, the document paper number is 20080728

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner, U.S Patent No. 6,092,102 in view of Menschik et al., U.S. Pre-Grant Pub No. 2004/0034550.
4. With respect to claim 1, Wagner discloses a system comprising a laboratory system data store (Col. 7 lines 15-24); a result posting module to post laboratory results and a callback module to identify a clinical laboratory result requiring a communication to the person placing the laboratory order (Col. 3 lines 47-56; col. 7 lines 38-52).

Wagner does not disclose an electronic medical record data store; however, Menschik does (¶¶ 90, 94). It would therefore have been obvious to one of ordinary skill in the art to

combine the teachings of Wagner with those of Menschik in order to facilitate medical data transfer among systems.

Claims 6 and 7 are rejected under the analysis of claim 1.

5. Claim 2 is rendered obvious, as Menschik recites HL7 which is a standard data exchange interface (§ 8).

Claim 8 is rejected under the analysis of claim 2.

6. With regards to claim 3, Wagner recites an event monitor analyzing lab results and generating a message type and content based on the event or data pattern (Col. 7 lines 38-52). Wagner does not specifically recite identifying a result based on information about the clinical laboratory order, however, a predictable result of his invention would be to include as many relevant triggering events or data patterns (e.g. clinical order data) in the event monitor in order to generate more specific or custom message types (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

Claims 4, 5, 9 and 10 are rejected under the analysis of claim 3.

7. Claims 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner, U.S Patent No. 6,092,102.

8. For claim 12, Wagner recites determining if the communication of laboratory result is successfully completed (Col. 8 lines 52-59). Wagner also recites different communication channels (Col. 8 lines 8-22), and resending a message to a user (Col. 14 lines 38-46). Wagner does not specifically recite identifying a second preferred method; however, a

predictable result of his invention would be to resend the message using one of the disclosed several other communication channels such as email, pager, PDA, telephone, fax etc. (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

Examiner also makes note that claim 12 is an optional step, and it has been held that, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II C).

Claim 19 is rejected under the analysis of claim 12.

9. Regarding claims 13-17, Wagner recites selecting communication channels based on user preferences (Abstract). Another predictable result of Wagner would therefore be for such preferences to include conditions (e.g. communication device availability, user availability or schedule) and communication channels (e.g. email, PDA, telephone, etc.) that optimize the message delivery.

Claims 20 and 21 are also rejected under the above analysis.

10. With respect to claim 18, Wagner recites a method comprising the steps of accessing a data store containing a plurality of clinical laboratory results (Col. 7 lines 15-24); selectively identifying a clinical laboratory result requiring communication (Col. 7 lines 38-52); identifying a first preferred notification method (Col. 4 lines 53-57).

Wagner does not specifically recite identifying a number of conditions for the preferred method, but he does disclose prior art that recites testing a set of criteria, and based on such criteria being met, performing an action such as sending a message (Col. 2 lines 64-67; col. 3 lines 1-2). Furthermore, the step of automatically generating a communication of laboratory

results if the conditions are satisfied is optional, and it has been held that, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II C). Therefore, the last limitation of claim 18 does not further limit the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Wagner, U.S. Patent No. 6,092,102.

13. With regards to claim 11, Wagner recites a method comprising the steps of accessing a data store containing a plurality of clinical laboratory results (Col. 7 lines 15-24); selectively identifying a clinical laboratory result requiring communication (Col. 7 lines 38-52); identifying a first preferred notification method (Col. 4 lines 53-57); and automatically generating a communication of the selected laboratory result by the first preferred method (Col. 7 lines 48-52).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

a) Ross Jr. et al., U.S. Patent No. 5,823,948 discloses material relevant to Applicant's invention.

b) Zakim, U.S. Patent No. 7,379,885 recites a database containing laboratory data, medical data and notifying a physician of lab results.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626